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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/764,632	01/26/2004	Raymond Anthony Joao	RJ213	9076

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07/14/2009

EXAMINER

LUBIN, VALERIE

ART UNIT

PAPER NUMBER

3626

MAIL DATE

DELIVERY MODE

07/14/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/764,632

Applicant(s)

JOAO, RAYMOND ANTHONY

Examiner

VALERIE LUBIN

Art Unit

3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 April 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Claims 1-20 are pending

For reference purposes, the paper number is 20090713

Response to Arguments

2. Applicant's arguments filed 4/13/09 have been fully considered but they are not persuasive.

3. The rejection of claims 1-20 under 35 USC § 112, 2nd paragraph is maintained. Applicant argues, "In re Schreiber, 128 F.3d 1473, 1478 (Fed. Cir. 1997) ('A patent applicant is free to recite features of an apparatus either structurally or functionally.');" see also Application of Swinehart, 439 F.2d 210, 212 (CCPA 1971) ("[T]here is nothing intrinsically

wrong with [defining something by what it does rather than what it is] in defining patent claims.). Examiner maintains that the claims are indefinite because they recite not only a processor but also the method performed by the processor, i.e. "processor generates a fourth data set..." It has been held that a claim that recites both an apparatus and a method for using said apparatus is indefinite under section 112, paragraph 2, as such a claim is not sufficiently precise to provide competitors with an accurate determination of the 'metes and bounds' of protection involved-IPXL Holdings LLC v. Amazon.com Inc., 77 USPQ2d 1140 (CA FC 2005); Ex parte Lyell, 17 USPQ2d 1548 (B.P.A.I. 1990)

4. The rejections of claims 1-20 under 35 USC § 103 is also maintained. Examiner reminds Applicant that it has been held that, " While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone -MPEP 2114; In re Swineheart, 169 USPQ 226; In re Schreiber, 44 USPQ2d 1429 (Fed. Cir. 1997)"

Mitcham recites an apparatus comprising a processor that processes insurance data and generates data concerning an insurance policy or premium based on the processed data, and at least one of a display device and an output device (Col. 2 lines 35-36). Mitcham also discloses data regarding information for generating insurance policy or premium information containing information regarding the entity to be leased and driving history of a leasing entity (Fig. 5-13).

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Independent claims 1, 8 and 15 are directed to apparatuses comprising a processor, a display device and an output device, but also recite method steps performed by the processor such as generating data. The claims are indefinite because they recite both apparatuses and method steps.

Claims 2-7, 9-14 and 16-20, as dependents of claims 1, 8 and 15 and reciting similar language, are rejected under the above analysis.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-3, 5-10, and 13-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mitcham U.S. Patent No. 5,537,315.

10. In claim 1, Mitcham recites an apparatus comprising a processor that processes insurance data and generates data concerning an insurance policy or premium based on the processed data, and at least one of a display device and an output device (Col. 2 lines 35-36). Mitcham also discloses data regarding information for generating insurance policy or premium information containing information regarding the entity to be leased and driving history of a leasing entity (Fig. 5-13).

Mitcham does not specifically recite that the insurance policy information is for excess wear and tear; however, this information is merely directed to the intended use of the data generated and it has been held that, "While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone" (-MPEP 2114; In re Swineheart, 169 USPQ 226; In re Schreiber, 44 USPQ2d 1429 (Fed. Cir. 1997)).

Claims 2, 3, 5, 8-10, 14-17 are rejected under the analysis of claim 1.

11. Claim 6 is rejected, as Mitcham discloses an input device (Col. 1 lines 28-33; col. 2 lines 35-36; col. 3 lines 34-37).

Claims 13 is rejected under the analysis of claim 6,

12. Claim 7 is rejected, as Mitcham recites a receiver and transmitter for communicating data with a remote communication device (Fig. 1; col. 3 lines 35, 53-61).

13. Claims 4, 11, 12, and 18- 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mitcham U.S. Patent No. 5,537,315 in view of Mintum U.S. Patent No. 5,692,501.

14. With regards to claim 4, Mitcham recites a processor generating insurance information (Fig. 13). He does not disclose the insurance information containing rebate incentive data; however, Mintum does disclose incentive features for insurance premiums (Abstract). It would have been obvious to one of ordinary skill in the art to combine the teachings of Mitcham and Mintum to provide a rebate incentive feature in order to attract and retain more customers.

Claims 11 and 18 are rejected under the analysis of claim 4.

15. For claim 12, Mitcham recites a processor that generates insurance and premium information (Fig 13). He does not disclose determining an amount of an insurance premium to be refunded; however Mintum discloses reducing premiums based on an incentive factor (Abstract; col. 9 lines 53-54). It would therefore have been obvious to one of ordinary skill to combine the teachings of Mitcham and Mintum to have the processor determine the amount of premium reduction based on the incentive provision in order to present the adjusted premium to the user and increase customer retention.

16. For claim 19, Mitcham and Mintum do not specifically recites identifying a credit derivative; however, systems to do so were old and well known in the art at the time the

invention was made. It would therefore have been obvious to one of ordinary skill in the art to combine the teachings of the prior art in order to provide additional value to customers.

Claim 20 is rejected under the analysis of claim 19.

Conclusion

17. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **VALERIE LUBIN** whose telephone number is (571)270-5295. The examiner can normally be reached on **Monday-Friday 7:30-4:30**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher L. Gilligan can be reached on 571-272-6770. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/V. L./

Examiner, Art Unit 3626

/Robert Morgan/
Primary Examiner, Art Unit 3626